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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Charles W. PROPST, Jr.

Group Art Unit: 1772

Serial No.: 09/914,185

Examiner: C. Bruenjes

Filed: August 23, 2001

Confirmation No.: 9479

For: CONDUCTIVE OR STATIC DISSIPATIVE COATING

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Reconsideration of the rejections set forth in the Office Action mailed May 12, 2006, is respectfully requested in view of the following comments.

Initially, applicant appreciates the withdrawal of claim objections under 35 U.S.C. §112, as set forth in paragraph (1) of the preceding Office Action.

Reconsideration of the rejection of claim 5 under 35 U.S.C. §102(e) as being anticipated by Wang et al (U.S. Patent No. 6,048,679) is respectfully requested.

Although the Examiner alleges that this claim is rejected under 35 U.S.C. §102(e), applicant respectfully directs the Examiner's attention to MPEP §706.02(IV) which states, in relevant part, "in other words, for anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly" (emphasis added). Instant claim 5 specifically recites "an aqueous methyl methacrylate polymer based solution containing a quaternary ammonium compound in an amount of 1-10 wt % based on the weight of the polymeric composition" The Examiner has noted the presence of the limitation "1-10 wt%" for the amount of quaternary ammonium compound, but alleges that such limitation "is not seen as limiting"

By the Examiner's ignoring of the express limitations of the claims and, furthermore, by the complete absence of this disclosure in the cited reference, the Board of Patent Appeals and Interferences will never sustain a rejection based upon 35 U.S.C. §102(e).

Not only does the Examiner recognize the presence of the express limitation (and the total absence of such limitations from the cited reference), the Examiner cannot avoid the absence of such limitation in the cited prior art by claiming the recited limitation "is not limiting."

It is clear that the limitation is limiting being based on the weight of the polymeric composition. It does not matter if the polymeric composition comprises 100 grams or 1000 grams, or any other amount, as the limitation of the amount of the quaternary ammonium compound is directly related to the weight of the polymeric composition.

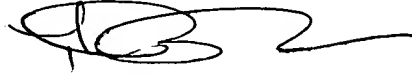
Furthermore, the sum of the Examiner's allegation that "clearly a film within the scope of that taught by applicant can be formed by Wang's process," completely misses the point of the anticipation rejection. That one skilled in the art would even try to make a film as claimed by applicant within the teachings of Wang is analogous to an obvious to try rejection rather than one of strict anticipation as set forth herein. Whether or not one of ordinary skill in the art would attempt to try to form a film as claimed with only the disclosure of Wang before him is simply irrelevant to the anticipation rejection. As this rejection would not be sustained by the Board of Patent Appeals and Interferences upon appeal, withdrawal of the rejection is respectfully requested.

Reconsideration of the previous rejection of claim 7 under 35 U.S.C. §103(a) as being unpatentable over Wang et al in view of Lu et al (U.S. Patent No. 5,130,177) is respectfully requested in view of the following comments.

It is clear that the Examiner cannot find the limitation of 1-10 wt % of quaternary ammonium compound based on the weight of the polymeric composition within the four corners of the teaching of Wang et al. Such a deficiency is not corrected by the citation of Lu et al. In view of the foregoing, the rejection of claim 7 under 35 U.S.C. §103(a) cannot be sustained and withdrawal of the rejection is respectfully requested.

Having fully responded to the previous Office Action, withdrawal of all rejections and passage of the application to issue are respectfully requested.

Respectfully submitted,



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